

## REMARKS

Applicants acknowledge receipt of an Office Action dated August 8, 2003. In this response Applicants have amended claims 3, 7, 10 and 14. Support for the amendments to claims 3, 7 and 10 may be found in the specification, *inter alia*, at page 5, line 5 *et seq.* Claim 14 has simply been redrafted in independent form by incorporating the features of independent claim 10 from which claim 14 previously depended. Following entry of these amendments, claims 2-14 are pending in the application. The PTO has withdrawn claims 3-9 from consideration as being drawn to non-elected subject matter. Applicants reiterate here their request for rejoinder and consideration of claims 3-9 upon allowance of claims to elected subject matter (see MPEP §821.04 and *In re Ochiai*, 1565 USPQ2d 1127 (Fed. Cir. 1995) ).

Reconsideration of the present application is respectfully requested in view of the foregoing amendments and the remarks which follow.

**Personal Interview**

Applicants wish to express their appreciation to Examiner Rajguru for the courtesies extended to Mr. Paul Strain during a personal interview conducted on October 22, 2003. During the interview, Mr. Strain and Examiner Rajguru discussed the outstanding rejection under 35 U.S.C. §103(a) based on U.S. Patent 4,857,594 to Lakshmanan (hereafter "Lakshmanan"). Mr. Strain pointed out the differences between permanent adhesives which are formulated to fail *cohesively*, *i.e.* through the adhesive itself, and removable adhesives which are formulated to fail *adhesively*, *i.e.* at the point of intersection between the adhesive and the substrate to which it is adhered. Applicants acknowledge with appreciation, Examiner Rajguru's indication that amending claim 10 to recite "[a] removable pressure sensitive sealant composition" and redrafting independent claim 14 in independent form may place the application in condition for allowance. In this response, Applicants have made the suggested amendments to claims 10 and 14.

**Rejections Under 35 U.S.C. §103**

On page 2 of the Office Action, the PTO has rejected claims 2 and 10-13 under 35 U.S.C. §103(a) as being unpatentable over Lakshmanan. Applicants respectfully request reconsideration of this rejection for the reasons set forth below.

In this response, Applicants have amended claim 10 to recite "[a] removable pressure sensitive sealant composition". As discussed during the above-referenced personal interview. Removable adhesives are different from permanent adhesives because the removable adhesives are formulated to fail *adhesively*, i.e. at the interface between the adhesive and the substrate. In contrast, permanent adhesives are formulated to fail *cohesively*, i.e. through the adhesive itself. This represents a fundamental difference between the permanent adhesive compositions of Lakshmanan and the removable compositions of present claim 10.

Applicants submit that the PTO has failed to establish a proper *prima facie* case of obviousness. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). See MPEP §2143.03. Here, Lakshmanan fails to teach or fairly suggest "[a] removable pressure sensitive sealant composition" as recited in claim 10. Further, as discussed in MPEP §2141.02, the PTO must consider both the invention and the prior art references *as a whole*. Here, a review of each of the disclosures of Lakshmanan and the present invention *as a whole* reveals that Lakshmanan relates to a hot melt adhesive having certain necessary properties, while the present invention relates to a pressure sensitive sealant having markedly different properties. Any failure to consider the *context* of the invention amounts to an improper refusal to consider both the invention and the prior art *as a whole*, as expressly required by § 103.

In contrast to the *removable* pressure sensitive sealant (designed for attaching vehicle light assemblies to a vehicle body) disclosed in the present application, the adhesive of Lakshmanan is used for *permanent* bonding. In other words, the presently claimed pressure sensitive sealant, which has a suitable removability (see page 1, lines 11-14, page 4, lines 25-30, the paragraph bridging pages 13 and 14 of the specification; also the first full paragraph on page 14), is materially different from hot melt adhesives (including that of Lakshmanan),

which are used for permanent bonding of plastic films to themselves or to other substrates, e.g., in the making of packaging. Lakshmanan states, for example, that “*it is absolutely necessary* that the adhesive used exhibit excellent adhesivity to such surfaces to hold the assemblies together *through their lifetime of use.*” (see column 2, lines 1-4). (Emphasis added). Thus, the hot melt adhesives of Lakshmanan have materially different properties, *by definition*, from those of the removable pressure sensitive sealants of the present invention.

The removability of the compositions of the present invention is described in the specification which includes the following passages among others:

[The present] pressure sensitive sealant [peels off well] under stress within the range of breaking elongation, thereby making an interfacial breaking so that the sealing composition can be readily peeled off from the surfaces of the rear combination lamp housing and the vehicle body panel without leaving the remains of the pressure sensitive sealant composition on the surfaces.” (see the paragraph bridging pages 13 and 14)

[The present invention] does not allow the remains of the pressure sensitive sealant composition to be left in an adhered state on the surfaces of the rear combination lamp housing and the vehicle body panel.” (para. bridging pp. 13 and 14).

Thus, Lakshmanan is not and cannot be a satisfactory “teaching reference” upon which to base an allegation of “obviousness” under §103. In the Office Action, the PTO recognizes “that the amounts taught by Lakshmanan are not exactly the same as those that are instantly claimed”, and the PTO states “that it is within the skill of one of ordinary skill in the art to use such variations in the amounts from those that are disclosed in the prior art in order to optimize the performance of end products and arrive at the claimed ranges..” Of course, this is not correct, since one “optimizing” Lakshmanan would be optimizing permanent adhesive properties and would clearly arrive at a much different composition having the much different properties than the presently claimed compositions.

Furthermore, the PTO has erred in stating that Lakshmanan discloses the same ingredients “in proportions that overlap those that are claimed.” The PTO has pointed to Table III, Run #6 of Lakshmanan for the alleged teaching that “Wax (as a plasticizer) is used at 47.5%,” thereby apparently implying that (1) wax is a plasticizer and that (2) the amount used falls within the claimed range for component (c) according to the claims. As to implication (2), Run #6 clearly fails to provide the alleged teaching, because Run #6 completely lacks a tackifier, fails to disclose a polymer according to component (a) in the claimed amount (Kraton GX-1657 is present only at about 5%), and Lakshmanan itself says with respect to this Comparative Example that “Run No. 6 resulted in a composition **exhibiting no adhesivity.**” (col. 10, lines 17-18, emphasis added). Moreover, this alleged “teaching” is contrary to the disclosure of Lakshmanan at column 5, i.e., that amounts of these optional ingredients in actual adhesive compositions can be “in an amount up to 40 weight percent.” Consequently, it is obviously incorrect to state that Lakshmanan discloses the same ingredients in overlapping proportions, i.e., the ingredients are not the same, the amounts are not the same, and Run #6 is not a composition according to the Lakshmanan invention. This disclosure in Lakshmanan is hardly the type of positive concrete teaching that is required to suggest the presently claimed invention.

Applicants note that, according to the embodiment of the invention of claim 10, the amount of component C (hydrocarbonic plasticizer) is clearly defined as being 42-62 wt% in order to obtain a suitable resilience (see page 1, line 32 to page 2, line 4; also page 2, lines 13-15 of the specification) and a suitable removability (see page 6, lines 20-21 of the specification) as a pressure sensitive sealant.

If the amount of component C is less than 42 wt%, resilience becomes too high, resulting in difficulty in a mechanical fastening of a rear combination lamp, on which the pressure sensitive sealant has been applied, to an automotive vehicle body panel (see page 16, lines 23-27 of the specification). If the amount of component C is greater than 62 wt%, resilience becomes too low, and this also produces difficulty in the mechanical fastening referred to above. Further, if the amount of component C is greater than 62 wt%, the cohesive force becomes too low and results in cohesive breaking (see page 13, line 27 to page 14, line 13 of the specification). As a result, it is difficult to easily and completely remove the

pressure sensitive sealant if the component C (hydrocarbonic plasticizer) is greater than 62 wt%.

Thus, it is possible to obtain a suitable removability if the component C (hydrocarbonic plasticizer) is within the claimed range of 42-62 wt%. The results shown in Table 5 of the specification provide further support for this assertion. In Table 5, Vehicle Nos. 1-5 according to the present invention showed a suitable removability, as compared with Vehicle No. 6 not according to the present invention (see page 22, lines 1-11; also see page 23, line 4 to page 24, line 2; and page 24, lines 8-15 of the specification). In each of Vehicles 1-5 in Table 5, the pressure sensitive sealant according to Example 2 of Table 1 was used (see page 20, lines 26-29; also page 19, lines 12-17; page 18, lines 19-23; also page 18, lines 19-23; and page 17, lines 11-19 of the specification). Example 2 contained 45 wt % of the component C (see Remarks, page 1, line 5 of the Amendment and Reply filed October 29, 2001), which is clearly within the claimed range of 42-62 wt%.

As to the implication (1) that wax in Run #6 is acting as a plasticizer, this is also incorrect. While there may be some overlap in the list of optional ingredients in column 5 of Lakshmanan and component (c) of the present invention, it is very clear that Shellwax 700 (a paraffin wax) is not included in such an overlap. The present specification does not list paraffin wax as an example of component (c), but rather in the list of optional additives at page 7, lines 24 to end of page. Paraffin wax is a solid, whereas liquid paraffin (which is listed as a possible ingredient (c)) is obviously a different composition, is naturally a liquid and is not disclosed in column 5 of Lakshmanan. Thus, Lakshmanan also lacks an adequate teaching as to the third component of Applicants' claimed composition.

For these reasons, it is submitted that Lakshmanan fails as a sufficient "teaching" under Section 103 to render *prima facie* obvious Applicants' claimed invention as claimed in claim 10 submitted with the previous response. Additional reasons for allowance of claim 10, particularly as amended, are presented below; however, Applicants respectfully submit that the foregoing deficiencies pointed out with respect to Lakshmanan as a basic teaching reference are completely sufficient to demonstrate that claim 10, even without amendment, is

patentable over Lakshmanan. Withdrawal of the stated rejection is therefore respectfully requested.

In a response filed July 8, 2002, Applicants amended the preamble of claim 10 to recite, "[a] pressure sensitive sealant composition consisting essentially of". (Emphasis added). The transitional phrase "consisting essentially of" limits the scope of the claim to the specified material and additional ingredients and/or in such amounts that do not materially affect the basic and novel characteristics of the claimed invention. Here, Lakshmanan's incorporation of an amorphous polypropylene (hereafter "APP") would materially affect the basic and novel characteristics of the presently claimed invention.

Lakshmanan's compositions incorporate APP in order to enhance compatibility of the hot melt adhesive with an olefinic substance (which is at least one of the two members to be bonded by the hot melt adhesive). At column 12, lines 42-45 of the specification, Lakshmanan states that "[t]he data in Table VI exemplify the *critical need* of combining the amorphous polypropylene and tackifier with a selectively hydrogenated alkenyl arene/conjugated diene block copolymer." (Emphasis added). In contrast, the claims to the pressure sensitive adhesive of the present invention do not permit any significant amounts of amorphous polypropylene, which is clearly a component that would affect the basic and novel characteristics of the compositions according to the present invention and is therefore excluded by the transitional phrase "consisting essentially of".

Independent claim 10 is therefore believed to be allowable. If an independent claim is nonobvious under §103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP 2143.03. Thus, Applicants submit that claims 1 and 11-13, which ultimately depend from claim 10, are also non-obvious.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of this rejection under §103.

**Claim 14**

In this response, Applicants have redrafted claim 14 in independent form by incorporating the features of claim 10, from which claim 14 previously depended. In view of the fact that the PTO did not reject claim 14 in the previous Office Action and in light of the PTO's indication, during the personal interview conducted on October 22, 2003, that claim 14 may be in allowable form if it was redrafted in independent form, Applicants submit that claim 14 is now in *prima facie* allowable form. Early notification to this effect is earnestly solicited.

**Non-Elected Method Claims**

In this response, Applicants have amended independent method claim 3 and 7 to recite "a removable pressure sensitive sealant composition" for consistency with claim 10. As discussed above, Applicants respectfully request rejoinder and consideration of claims 3-9 upon allowance of claims to elected subject matter (see MPEP §821.04 and *In re Ochiai*, 1565 USPQ2d 1127 (Fed. Cir. 1995) ).

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully submit that all of the pending claims are now in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application, the Examiner is invited to contact the undersigned at the number below. The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith,

Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date December 8, 2003

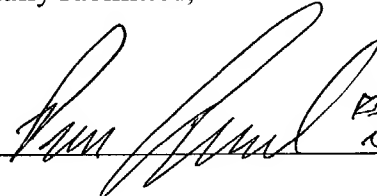
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